



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,965	04/16/2004	Philippe Hesse	101769-251 / tesa AG 1632	1478
27384	7590	07/19/2006	EXAMINER	
NORRIS, MCLAUGHLIN & MARCUS, PA 875 THIRD AVENUE 18TH FLOOR NEW YORK, NY 10022			TRAN, THAO T	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 07/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/826,965

Applicant(s)

HESSE ET AL.

Examiner

Thao T. Tran

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
4a) Of the above claim(s) 6-10, 12, 14, 18-20 and 23-35 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-5, 11, 13, 15-17, 21, 22, 25 and 35 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/23/04, 5/27/04, 4/16/04
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claims 6-10, 12, 14, 18-20, 23-35 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected Inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 4/18/2006. Note that claims 18-20 were inadvertently grouped in species (a), whereas they should be in species (b) because these claims depend from claim 6. Thus, claims 18-20 are now withdrawn together with other claims in species (b).

2. Applicant's election with traverse of Group I, Species (a) including claims 1-5, 11, 13, 15-17, 21-22, 25, and 35, in the reply filed on 4/18/2006 is acknowledged. The traversal is on the ground(s) that examination of the Groups I and II, and species (a) and (b) would be a serious search burden to the examiner. This is not found persuasive because the claims of Group I are directed to a product, whereas those of Group II to a process of making. These are different Inventions acquiring a separate status in the art in view of their classification and recognized divergent subject matter. Hence, these two Inventions require different searches. Moreover, species (a) and (b) are directed to polypropylene glycols of different molecular weight, also requiring different searches. Thus, restrictions of these groups of claims are proper.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5, 11, 13, 15-17, 21-22, 25, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ikuma (JP-06279741) or Anderson (US Pat. 6,463,026) in view of Schumann et al. (US Pat. 7,033,668).

Ikuma discloses a heterogeneous double-sided adhesive tape, comprising a substrate sheet 1, an adhesive layer 12 and a self-adhesive layer 13 (see abstract; Fig. 1). The adhesive layer 12 is a pressure sensitive adhesive of polyurethane prepared from reacting a polyol mixture with organic diisocyanate (see [0015]). The self-adhesive layer 13 is a glue line (see [0016]). Thus, the two adhesive layers differ in adhesive strength. The adhesive tape can also further comprise a backing layer (see paragraph bridging col. 8-9).

Ikuma, however, does not specify the molar mass or amount of the polyol or isocyanate-reactive compounds as presently claimed.

Anderson discloses an optical disc label 110, comprising an adhesive system 112. The adhesive system 112 comprises adhesive layers 114, 115, and 116 (see Fig. 10; col. 7, ln. 50-66). The adhesive is a low tack or repositional acrylic-based adhesive (see col. 5, ln. 13-18). The label can also comprise a removable liner 70 (backing layer) (see col. 5, ln. 43).

Anderson, however, does not teach one adhesive layer to be a polyurethane of the presently claimed invention.

Schumann discloses a double-sided adhesive tape, comprising a film of a pressure sensitive adhesive (see col. 3, ln. 44-45, 63-67). The PSA is polyurethane-based (see col. 5, ln. 4-22). The polyurethane is prepared from 7.8 parts of isophorone diisocyanate and 100 parts of polypropylene glycols, giving an NCO/OH ratio of 0.95, which reads on the instantly claimed ranges. The polypropylene glycol comprises 88.5 % by weight of a triol and 6.4 % by weight of a diol (see col. 11, ln. 60-67; col. 12, ln. 1-20); wherein the triol has a molar mass of 6,200 and the diol a molar mass of 430 (see Table 3), which meet the requirements of the polypropylene glycol with a functionality of more than 2.0 and the other isocyanate-reactive starting material with a nominal functionality of 2.0 respectively.

Therefore, it would have been obvious to one of ordinary skill in the art to have employed the polyurethane, as taught by Schumann, in the pressure sensitive adhesive of Ikuma or removable adhesive of Anderson, because the use of these reactants in forming polyurethane PSA has been conventionally practiced in the art to provide strong bond while permitting removal without tearing the adherend.

Ikuma is silent with respect to the adhesive tape adhered to a CD, DVD, or a card. However, the reference discloses the adhesive tape being adhered to a surface, such as a dirt removal mat, support sheet, radical sheet member (see Description of Drawings). Therefore, it would have been obvious to one of ordinary skill in the art that the adhesive tape of Ikuma would have been adhered to a CD, DVD, or a card and would have worked as equally well.

Art Unit: 1711

Contact Information

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 571-272-1080. The examiner can normally be reached on Monday-Friday, from 9:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

tt
June 21, 2006


THAO T. TRAN
PATENT EXAMINER